

II. REMARKS

A. Introduction

Applicant submits this Response in a bona fide attempt to (i) advance the prosecution of this case, (ii) answer each and every ground of objection and rejection as set forth by the Examiner, (iii) place the claims in a condition for allowance, and (iv) place the case in better condition for consideration on appeal. Applicant respectfully requests reexamination and reconsideration of the above referenced patent application in view of this Response.

As indicated above, the specification has been amended to reflect that the subject Application is a Continuation Application of International Application No. PCT/AU02/00709, which claims priority from Australia Application No. PR5518, filed June 6, 2001.

Claims 1, 3, 4 and 6-15 have also been amended and Claim 5 has been canceled. New Claim 18 has also been added.

Applicant respectfully submits that the noted claim amendments (and new claim) merely make explicit that which was (and is) disclosed or implicit in the original disclosure. The amendments thus add nothing that would not be reasonably apparent to a person of ordinary skill in the art to which the invention pertains.

B. Response to Objections

The Examiner has rejected Claims 8 and 9 under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner contends that there is insufficient basis for the limitation "said handle" in Claim 1.

As indicated above, Claim 7 is directed to the inclusion of the subject handle. Claim 8 has accordingly been amended to reflect dependence on Claim 7.

C. Response to Rejections

1. 35 U.S.C. § 102

The Examiner has rejected Claims 1 and 3-10 "under 35 U.S.C. § 102 (b) as being anticipated by D'Antonio (4,416,387)." The Examiner contends, *inter alia*:

Regarding claims 1 and 10, D'Antonio discloses a device (22) for sealing paint in a container having a base and a cylindrical wall (Figures 1-4, column 2, lines 19-25). The device has a circular disk (24, column 2, lines 39-56) and a side wall (36) extending outward with a horizontal lip (48) that engages the inner surface of the container.

It is well established that a rejection for anticipation under § 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *See In re Paulsen*, 30 F.3d 1475, 1478-79, 31 U.S.P.Q. 2d 1671, 1673 (Fed. Cir. 1994); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 U.S.P.Q. 2d 1001 (Fed. Cir.1991). *See also American Permahedge, Inc. v. Barcana, Inc.*, 857 F. Supp. 308, 32 U.S.P.Q. 2d 1801, 1807-08 (S.D. NY 1994) (“Prior art anticipates an invention ... if a single prior art reference contains each and every element of the patent at issue, operating in the same fashion to perform the identical function as the patent product. ... Thus, any degree of physical difference between the patented product and the prior art, *no matter how slight*, defeats the claim of anticipation.”); *Transco Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1462 (Bd. Pat. App. & Int’l 1990) (“[I]t is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference”).

Applicant respectfully submits that Claim 1 and Claims 3 – 10, dependent thereon, are not anticipated by D’Antonio. Indeed, as discussed below, D’Antonio clearly does not disclose “each and every limitation of the claimed invention”.

A key feature and, hence, advantage of Applicant’s invention is the provision of a removable membrane for a cylindrical container that is capable of locking a portion of the container contents (whether air, paint or any other substance) into a “vacuum sealed” segment of the container. The removable membrane also provides a sealed interface with the container inner wall that is robust against tilting of the container and to the resultant pressure exerted by flowing liquid beneath the membrane.

The robust sealing of Applicant’s membrane is provided, in significant part, by the flexible seal perimeter, which includes a multi-sectioned, flexible side wall.

Claim 1, as amended, thus reflects (i) a side wall having at least three sections that extend outwardly from the membrane base or disk and (ii) the provision of a sealed membrane (or device) and container wall interface that is “maintained during non-vertical and inverted orientations of the container”.

D’Antonio simply does not teach (or, as discussed below, suggest) either of the noted, limitations of Claim 1 and, hence, Claims 3 – 10, dependent thereon. Applicant accordingly respectfully requests that the rejection under 35 U.S.C. § 102 be withdrawn.

2. 35 U.S.C. § 103

The Examiner has also rejected Claims 2, 7, 11-14, 16 and 17 under 35 U.S.C. § 103(a) “as being unpatentable over D’Antonio in view of Leach (4,312,459).” The Examiner contends:

Regarding claim 2, D’Antonio discloses the invention except for the side wall extending angularly upward from the disk. Leach discloses a similar device 70, (Figure 6, column 3, lines 50-57) with a side wall (71) that extends angularly upward from the disk. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a side wall portion that extends angularly upward as disclosed by Leach in the device disclosed by D’Antonio replacing the outer wall (42) to allow the resilience of the material to provide more outward pressure on the lip for fitting the lip against the inner surface of the container to allow for inconsistencies in the roundness of the cylindrical container wall.

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Regarding claim 11, D’Antonio discloses a device for sealing paint in a can having a flat circular disk (24) with a flat lower surface intended for fitment in the can, a circular side wall (36) that would have an arcuate profile and a horizontal outer rim (48) having a perimeter diameter that exceeds the diameter of the can.

D’Antonio does not teach the side wall extending angularly upward from the disk. Leach discloses a similar device 70, (Figure 6, column 3, lines 50-57) with a side wall (71) that extends angularly upward from the disk. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a side wall portion that extends angularly upward as disclosed by Leach in the device disclosed by D’Antonio replacing the outer wall (42) to allow the resilience of the material to provide more outward pressure on the lip in fitting the lip against the inner surface of the container to allow for inconsistencies in the roundness of the cylindrical container wall.

In determining what is and what is not obvious under § 103, ***all properties and advantages not in the prior art must be considered***. See *In re Wright*, 848 F.2d 1216, 6 U.S.P.Q. 2d 1959, 1962 (Fed. Cir. 1988) (“Factors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness in terms of 35 U.S.C. § 103”). Indeed, it is the invention as a whole, including distinct functions that must be considered in obviousness determinations.

Further, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the

combination. See *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 922 (Fed. Cir. 1984).

Applicant respectfully submits that Claims 2, 7, 11-14, 16 and 17 define an invention that is unobvious over the cited references, alone or in combination.

As indicated above, a key feature and, hence, limitation of Applicant's invention is the provision of a removable membrane for a cylindrical container that includes a flexible seal parameter, which, when inserted into the container, provides a sealed interface that is independent of the container contents, e.g., liquid. The seal also maintains its integrity when the container is dislodged, shaken, inverted or otherwise disturbed, and when pressure is exerted by flowing liquid beneath the membrane.

As is well known in the art, the liquid surface in a vertical cylindrical container conforms to the geometry of the can. When the container is tilted (just a few degrees, as will happen, for example, when the container is placed on a high shelf) the surface geometry of the liquid within the container changes from a circle to an ellipse. Although this change of surface geometry may only be temporary, a "floating seal" that is circular and has no independent means for securing itself to the container wall (other than a bond between the container wall and a seal caused by drying paint) will become partially or fully dislodged by the force of gravity on the liquid, e.g., paint, and allow the liquid to flow pass the seal. Subsequently, upon return to a vertical container orientation, the floating seal can, and in many instances will, (i) become attached to old and drying paint along the container wall and fail to return to its intended position and/or (ii) partly return to its intended position, allowing a steep angle relative to the paint surface to insue, thereby causing submersion of part of the perimeter of the seal (the edge of the seal may in fact "dive" beneath the paint and progressively sink the seal) and thereafter fail to adequately seal the target container region.

As discussed in detail herein, Applicant's membrane overcomes the noted problems that are associated with floating seals, such as that disclosed by D'Antonio.

a. Claims 2 and 7

As discussed in detail above, Claim 1, as amended, includes the following limitations: (i) a side wall having at least three sections that extend outwardly from a disk and (ii) the provision of a sealed membrane and container wall interface that is "maintained during non-vertical and inverted orientations of the container".

Applicant respectfully submits that D'Antonio does not teach or suggest either of the noted limitations of Claim 1. Claim 1 and, thus, Claims 2 and 7, dependent thereon, should accordingly be deemed allowable.

b. Claims 11-14, 16 and 17

Independent Claim 11, as amended, similarly includes a multi-sectioned side wall that is adapted to sealably engage the inner wall of the container when the membrane is inserted therein. The multi-sectioned, flexible side wall facilitates a robust seal that is maintained non-vertical and inverted orientations of the container.

In contrast, seal D'Antonio does not teach or suggest any means of “securely” attaching the disclosed seal to the inner wall of the container. D'Antonio discloses that the seal must flow upon the surface of the paint where the air is evacuated “once the device is seated on the liquid to be preserved”. (see Col. 1, ll. 48-51). A partial vacuum thus lies between the seal and the paint surface.

Referring to Figure 1 of D'Antonio, it is obvious to one having ordinary skill in the art that the outer lowered section of the seal (40) is in contact with the paint surface, yet is traversed by two raised ribs (44), wherein air or liquid can, and in all likelihood will, flow to the outer horizontal rim or flange (48). Thus, when the container is tilted (especially along an axis allowing direct flow of the liquid to either rib 44), liquid will flow into this “air lock” and the air contained therein will retreat to the rib side (44) where little, if any force, will be required for the air and liquid to burst free along the upper wall of the tilted container. If tilting the container results in the liquid flowing in the direction perpendicular to the axis of the raised center handle, the weight of the liquid gains a further advantage in terms of disrupting the seal, which already has a folding means along the liquid's horizon, and will be readily forced away from the wall of the container, thereby assuring the collapsed of the seal. Even if the seal returns to its intended position when the container is in a vertical orientation, the seal will no longer have the advantage of a partial vacuum to hold it to the paint surface; unless, the raised handle is again manually squeezed to a evacuate the air that has found its way under the seal during the tilting activity.

In contrast, Applicant's invention is not handicapped by the need to position it on the surface of a liquid and rely on surface contact to achieve a seal. Applicant's multi-sectioned, flexible side wall provides a sealed interface between the sealing device and container wall, which is maintained during non-vertical and inverted orientations of the container.

Applicant accordingly respectfully submit that Claim 11 and Claims 12-14, 16 and 17, dependent thereon define an invention that is unobvious over D'Antonio and Leach, alone or in combination. Claims 11 – 14, 16 and 17 should thus be deemed allowable.

III. CONCLUSION

Applicant having answered each and every ground of rejection as set forth by the Examiner, and having added no new matter, believes that this response clearly overcomes the references of record, and now submit that all claims in the above-referenced patent application are in condition for allowance and the same is respectfully solicited.

If the Examiner has any further questions or comments, Applicant invites the Examiner to contact his Attorneys of record at the telephone number below to expedite prosecution of the application.

Respectfully submitted,
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